

REMARKS

Upon entry of the instant amendment, claims 1-2 and 5-13 will remain pending in the above-identified application and stand ready for further action on the merits.

In this Amendment, claim 1 has been amended and new claims 10-13 have been added. Support for amended claim 1 and newly added claims 10-13 can be found at page 10 of the present specification.

Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1, 2, 5, 6, and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Reddy et al.** (WO 03/024958).

Claims 1, 2, 5, 6, 8, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Sanin et al.** (Russian Journal of Organic Chemistry, Vol. 35, No. 5, 1999).

Reconsideration and withdraw of the instant rejection is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

MPEP § 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP § 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) *combining prior art elements according to known methods to yield predictable results;*
- (b) *simple substitution of one known element for another to obtain predictable results;*
- (c) *use of known technique to improve similar devices (methods, or products) in the same way;*
- (d) *applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;*
- (e) *“obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success*
- (f) *known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;*

- (g) *some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.*

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP § 2143.03.

Distinctions over the Cited Art

Both references being relied upon by the USPTO are direct to a reaction of trifluoroacetyl compounds, which allegedly correspond to the reaction of the present invention wherein Y is a trifluoroacetyl group.

The trifluoroacetyl group can highly activate the reactivity of a carbon-carbon double bond, and the references focus on specific compounds, namely trifluoroacetyl compounds.

In contrast to the teachings and disclosure of the cited art, the present invention directs to a chemical reaction of esters and nitriles.

As such, it is submitted that the disclosed chemical reaction of trifluoroacetyl compounds in the references is incapable of rendering or otherwise making the present invention obvious.

In particular, it is noted that the cited art fails to provide any disclosure or reason or rationale to those of ordinary skill in the art that would allow them to arrive at the instant invention as claimed.

Accordingly, any contentions of the USPTO to the contrary are respectfully requested to be reconsidered at present as they are not sustainable.

CONCLUSION

In view of the amendments and remarks presented herein, the USPTO is respectfully requested to issue a Notice of Allowance in the matter of the instant application clearly indicating that each of instantly pending claims 1-2 and 5-13 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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